

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

DOCKET NO. AUS920000192US1

In re Application of:

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DUTTA ET AL.

Examiner: **JAVID A. AMINI**

Serial No.: 09/583,346

Art Unit: 2628

Filed: May 31, 2000

Confirmation No.: **2382**

**For: SYSTEM AND METHOD FOR  
DISPLAYING DATA ON A PORTABLE DEVICE**

Confirmation No.: **2382**

**REPLY BRIEF UNDER 37 C.F.R. 41.41**

Commissioner for Patents  
Mail Stop Appeal Briefs – Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated December 9, 2010.

## **ARGUMENT**

Appellants note with appreciation the withdrawal of the final rejection of Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, as well as the final rejection of Claims 20-21, 23-26, 30 and 33 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement (see, e.g., Examiner's Answer, p. 3).

In view of the withdrawal of these rejections, the only remaining rejection at issue is the final rejection of Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-30 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,661,632 to *Register* in view of U.S. Patent No. 6,453,173 to *Reber et al. (Reber)*. Appellants respectfully maintain that this rejection should be reversed for the reasons set forth in Appellants' Appeal Brief, which is incorporated herein by reference. To address the additional points raised in the Examiner's Answer, Appellants provide the following additional arguments for reversal.

### **I. Section III.A. of the Argument**

In Section III.A. of the Argument, Appellants demonstrated from the record that independent Claims 28-30 are not rendered unpatentable by the combination of *Register* and *Reber* because that combination of references does not disclose or render obvious "the portable device analyzing the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display," as recited in exemplary Claim 28. In particular, Appellants demonstrated that the combination of *Register* and *Reber* does not disclose any analysis of the data page, but instead discloses the reorientation of a display screen image in response to a user toggling between portrait and landscape display modes using manually manipulable toggle buttons on a handheld computer.

In response, the Examiner now argues in substance:

1. "[it] would have been obvious to one of ordinary skill in the art to equate as analyzing the data page[,] i.e.[,] the display screen image #26 of fig. 4 into #52 of fig. 5;"
2. "Register uses toggle switches for analyzing of data page;"
3. "Reber uses an optical reader for analyzing of data page for different orientations of the handheld devices ... Reber at col. 13, lines 4-10

discloses the embodiment described with reference to FIGS. 9 and 10 is advantageous in automatically varying the scanning axis of the light beam in dependence upon the orientation of the handheld device.”

Addressing these points *in seriatim*, Appellants first note that the Examiner has the burden to establish a *prima facie* case of obviousness by a preponderance of the evidence (see, e.g., MPEP 2142). In discharging that burden, “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex, Inc., et al.*, 550 U.S. 398, 418 (2007). In the Examiner’s first contention, the Examiner asserts that a person of ordinary skill in the art would “equate” *Register*’s disclosure of a display screen image in two orientations with the claimed step of “the portable device analyzing the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display,” as recited in Claim 28. However, the Examiner has provided no objective evidence or articulated reasoning with rational underpinning supporting his contention that a person of ordinary skill in the art would consider the display of an image in a user-determined orientation to be equivalent to a portable device analyzing a data page to determine an orientation for presentation of the data page. Certainly the common capability of both the claimed method and the combination of Register/Reber to display an image in multiple orientations does not somehow equate the disparate methods to achieve that common capability. As such, it is clear that the Examiner’s first contention is precisely the type of “mere conclusory statements” that *KSR* categorically declared were insufficient to support a *prima facie* case of obviousness.

The Examiner’s second contention that “*Register* uses toggle switches for analyzing of data page” similarly lacks any supporting objective evidence or articulated reasoning with some rational underpinning. To support this contention, the Examiner would have to demonstrate in view of the present specification that the broadest reasonable interpretation of the claim phrase “the portable device analyzing the data page to determine an orientation for presentation of the data page” is expansive enough to encompass *Register*’s disclosure of a user toggling between portrait and landscape display modes using manually manipulable toggle buttons. With all due respect, Appellants submit that there is no possible construction of the claim phrase in question

or of its constituent terms that would permit the claim phrase in question to encompass *Register*'s disclosure. In any event, the Examiner has not provided any objective evidence or articulated reasoning supporting such a claim construction. Consequently, the Examiner's second contention must likewise fail.

The Examiner finally cites Figures 9-10 and col. 13, lines 4-10 of *Reber*, which disclose:

The embodiment described with reference to FIGS. 9 and 10 is advantageous in automatically varying the scanning axis of the light beam in dependence upon the orientation of the handheld device. Regardless of whether the handheld device is oriented to display content in portrait mode (FIG. 9) or in landscape mode (FIG. 10), the light beam is scanned horizontally to read horizontally-oriented bar codes.

As further elaborated at page 6 of the Examiner's Answer, the Examiner believes that in light of the foregoing disclosure of *Reber* "it would have been obvious ... to modify the teachings of *Reber*'s light beam into *Register*'s toggle switches in order automatically varying [sic] an axis of scanning light beam in dependence upon an orientation of the handheld device." In response, Appellants simply note that the orientation-dependent handheld scanner allegedly obtained by the Examiner's combination of *Register* and *Reber* does not disclose or render obvious the invention actually recited in exemplary Claim 28, and that the Examiner does not provide any objective evidence or articulated reasoning demonstrating that the orientation-dependent handheld scanner allegedly resulting from the combination of *Register* and *Reber* "analyz[es] the data page to determine an orientation for presentation of the data page," as claimed.

In view of the foregoing, Appellants respectfully submit that the three contentions raised in the Examiner's Answer do not establish a *prima facie* case of obviousness with respect to Claims 28-30 and their respective dependent claims. Consequently, the final rejection of Claims 28-30 and their respective dependent claims under 35 U.S.C. § 103 in view of the combination of *Register* and *Reber* should be reversed.

## **II. Sections III.B. and III.C. of the Argument**

Appellants also note that the Examiner has confined the response to Appellants' Argument to independent Claims 28-30 and does not dispute Appellants' position that the

Examiner has failed to make a *prima facie* case of obviousness with respect to Claim 6 (or similar Claims 15 and 24) and Claim 7 (or similar Claims 16 and 25). Accordingly, it should be apparent that the final rejection of Claims 6-7, 15-16 and 24-25 under 35 U.S.C. § 103 in view of the combination of *Register* and *Reber* is not well founded and should be reversed.

### **III. Summary**

The foregoing arguments demonstrate that the present claims are not rendered unpatentable under 35 U.S.C. § 103 by the combination of *Register* and *Reber*. Appellants therefore respectfully request the Board to reverse the rejection of each pending claim.

Please charge any fees that are required to IBM Corporation Deposit Account No. **09-0447**.

Respectfully submitted,

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